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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/698,358

11/03/2003

Kirk G. Scheckel

SCHECKELI

1126

1444 7590 04/25/2007
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EXAMINER

BARRY, CHESTER T

ART UNIT

PAPER NUMBER

1724

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/698,358

Applicant(s)

SCHECKEL ET AL.

Examiner

Chester T. Barry

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-10 and 27 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 11-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claims 1 – 6, 8-10, 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 is purported to “remov[e]” certain types of contaminants from water simply by contacting the contaminated water with an effective amount of a ruthenium compound, i.e., without any other simultaneous or subsequent processing steps, because the transition phrase “consisting of” is used. Although the specification enables the removal of certain contaminants out of **solution** by merely contacting the same with certain solid phase forms of ruthenium compounds (see [0119] line 2), the specification fails to enable “removal” of such contaminants from water altogether without at least a subsequent filtration step even when ruthenium oxide is the ruthenium compound. For want of recital in the claims of the step of separating the ruthenium compound from the treated water subsequent to the recited contacting step, the claimed invention is not enabled. Furthermore, the invention is not enabled for all ruthenium compounds, e.g., ruthenium metal, even though it is enabled for ruthenium oxides and bimetallic alloys comprising ruthenium. Further narrowing is required so that the claimed scope is enabled.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear whether Claim 27 should be interpreted as if it recited “contacting the water with an effective amount of . . . at least one member

selected from the group consisting of activated carbon” etc., or as if it recited “contacting the water with . . . at least one member selected from the group consisting of activated carbon.” Separately, it is unclear what it means to contact water with either “sand filtration” or “reverse osmosis.” If applicants instead intended to recite, “contacting the water with . . . at least one member selected from the group consisting of activated carbon, ion exchange media, ozone, and ultraviolet light, or at least one processing step selected from the group consisting of sand filtration and reverse osmosis,” then applicants should consider amending the claim appropriately.

Claims 1 – 6, 8-10, 27 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 5985790 to Moskovitz. Moskovitz describes removing contaminants from water by contacting the water with solid particles of ruthenium oxide col 4 lines 45, 58, alone or in combination with activated carbon col 5 line 12.

It is unclear why the claim listing filed 11/17/06 bears the footer “Copied from 10501987 on 11/27/06.” To the extent that “10501987” refers to US Patent Application No. 10/501,987, the pending application and the cited application do not appear to be related. It is noted that the pending claims do not appear to have been copied from

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10/501,987. A reduced facsimile of the lower half of page 7 filed 11/17/06 is shown below:

27. (New) A method for removing chemical and biological contaminants from water consisting of contacting the water with an effective amount of at least one ruthenium compound and at least one member selected from the group consisting of activated carbon, ion exchange media, ozone, ultraviolet light, sand filtration, and reverse osmosis.

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Copied from 10501987 on 11/27/2006

Note the footer reference to 10501987 below the page number "7."

A handwritten signature in black ink, appearing to read "Chester T Barry", with a large, stylized flourish extending from the end of the signature.

Chester T Barry

Examiner

571-272-1152